

## **REMARKS**

The non-final Office Action dated March 30, 2009 (hereinafter, “Office Action”) has been reviewed and the Examiner’s comments considered. Claims 1-21 are currently pending in the application. Claims 1, 6, 19, 20, and 21 are amended. Applicants submit that no new matter is introduced. Support for the amendments to claims 19 and 21 is found in at least paragraph [0053] and Figure 5. (See US Pub 2007/0191925, the publication for the instant application.)

### **Claim Rejections – 35 U.S.C. § 102**

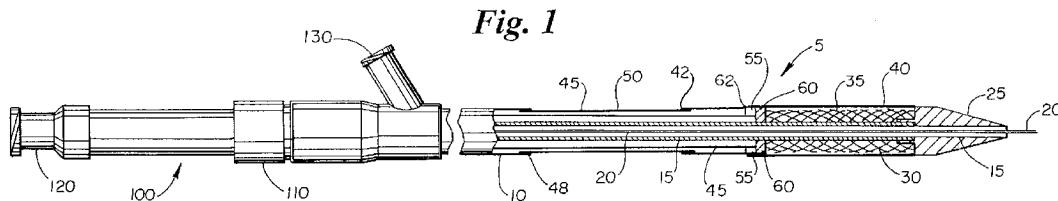
Claims 1-3, 5-8, 10-15, and 19-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by USPN 5,534,007 to St. Germain et al. (hereinafter, “St. Germain”). Applicant respectfully traverses this rejection.

In contradistinction to the St. Germain disclosure, Applicant claims a catheter device that includes a shaft that extends from a proximal end to a distal end.

Independent claim 1 recites, *inter alia*, “[a] catheter device comprising: a shaft that extends from a proximal end to a distal end” (emphasis added). The Office Action alleges that “St. Germain teaches a catheter device comprising: a shaft (15).” As the MPEP states, “‘All words in a claim must be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).” (MPEP § 2143.03) The Office Action fails to consider all words in the claim. Specifically, the shaft extending from a proximal end to a distal end is not considered.

More importantly, St. Germain fails to teach “[a] catheter device comprising: a shaft that extends from a proximal end to a distal end.<sup>1</sup>” St. Germain teaches “a hydrating luer 130, which is preferably located on the distal end of the manifold 100” (col 4:62-64). This is also shown in Figures 1-5. Accordingly, the shaft does not extend from a proximal end to a distal end. As the MPEP states, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir.

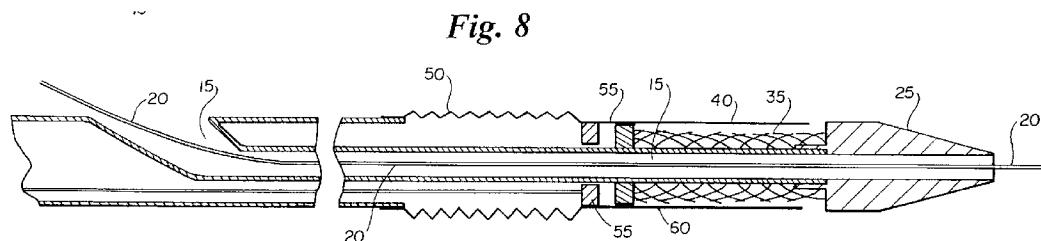
1989)." (MPEP § 2131). Nothing in St. Germain provides any discussion, let alone the details contained in claim 1, related to the shaft extending from a proximal end to a distal end.



Additionally, Figure 8 (below) "shows a side view of a catheter according to an alternative embodiment of the invention having a loaded stent including a cross-sectional view of the distal portion thereof" (col. 2:54-57, emphasis added).

FIG. 8 illustrates a rapid exchange embodiment of the invention. The distal end of the catheter is structured and functions in the same fashion as that of the device shown in FIG. 1. The overall length of the catheter is approximately 135 cm, while the length of the guide wire lumen 15 is between approximately 5 cm to 35 cm from the distal tip 25 to a point where the guide wire lumen 15 and the guide wire 20 exit the catheter

(col. 6:45-49, emphasis added). If the overall length of the catheter is "approximately 135 cm" and the "length of the guide wire lumen is between approximately 5 cm and 35 cm" clearly, the shaft cannot extend from a proximal end to a distal end.



Accordingly, at least for the reasons set forth above, Applicant respectfully submits that independent claim 1 and claims 2-3, 5-8, 10-15, and 20, depending therefrom are patentable over St. Germain. Independent claims 19 and 21, as amended, include similar limitations to claim 1, specifically, a shaft that extends from a proximal end to a distal end. Therefore, Applicant

respectfully requests favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 102.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 4, 9, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over St. Germain. Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over St. Germain in view of USPN 6,514,196 to Sullivan et al. (hereinafter, “Sullivan”).

Without conceding the propriety of the asserted combinations, or the assertions made in the Office Action with respect to the allegedly disclosed subject matter, Applicant submits that each of the rejected claims 4, 9, 16, 17, and 18 depends from patentable independent claim 1 and is therefore patentable. Accordingly, Applicant requests favorable reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

### **Conclusion**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

It is noted that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between the cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein should not be construed to prejudice or foreclose future consideration by Applicant of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner and/or the merits of additional or alternative arguments.

Application No. 10/580,200  
Amendment dated June 30, 2009  
Reply to Office Action of March 30, 2009

Docket No.: 101671.0043P

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. **50-2191** referencing docket no. 101671.0043P. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: June 30, 2009

Respectfully submitted,

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